

REMARKS/ARGUMENTS

Claims 1-21 are active in this application. The elected portion of Claims 1-12 is drawn to a process of preparing amines of the formula III wherein  $R^1 - R^4$  are independently selected from the group consisting of H, C<sub>1</sub>-C<sub>24</sub> alkyl, C<sub>2</sub>-C<sub>24</sub> alkenyl, C<sub>2</sub>-C<sub>24</sub> alkynyl, C<sub>6</sub>-C<sub>10</sub> aryl, CF<sub>3</sub>; wherein  $R^6 - R^9$ , in the mono-dentate or bi-dentate ligand, are independently selected from the group consisting of H, C<sub>1</sub>-C<sub>24</sub> alkyl, C<sub>2</sub>-C<sub>20</sub> alkenyl, C<sub>3</sub>-C<sub>8</sub> cycloalkyl, C<sub>5</sub>-C<sub>8</sub> cycloalkenyl, C<sub>6</sub>-C<sub>14</sub> aryl, phenyl, naphthyl.

Applicants thank the Examiner for indicating that the elected subject is deemed to be allowable. In addition, the Examiner citing the closest prior art of Marko et al (Ref. AW), has recognized that the claimed process is different from this publication, for example, in view of the different catalysts used in the Marko et al publication. In particular, Applicants also point out that in the specification on page 3, the Applicants describe:

It has now surprisingly been found that the desired amines can be obtained very efficiently by the reductive amination of ketones and aldehydes in the presence of catalytically active transition metal complexes based on phosphorus-containing ligands under very mild conditions.

Under these mild reaction conditions, an enantioselective reaction is possible when using chiral ligands.

The transition metal catalysts used give good to very good yields of the desired amine in the reductive amination. At the same time, a very high amine/alcohol ratio in the products can be achieved.

The process of the invention overcomes the known disadvantages of the metal-catalyzed reductive aminations described hitherto.

The successes of the claimed process are demonstrated in the Examples of the application. In particular, Applicants direct the Examiner's attention to Tables 1-5 on pages 21-25, which summarize the results of various reductive amination reactions and enantioselective synthesis (Table 5).

While Applicants affirm the election of Group I, Applicants respectfully request that the Examiner reconsider and withdraw the Restriction in view of the following.

The Restriction Requirement is based on the ground that unity of invention does exist between Groups I-V because there is not a technical relationship that involves the same special technical feature. However, there is a technical feature in the claimed invention, namely the discovery that reacting ketones with amines in the presence of hydrogen and a homogenously soluble catalyst system to prepare substituted amines as defined in the claims allows the performance of the reaction under mild conditions without the problems normally associated with the preparation of substituted amines (refer to the specification on pages 1-2 for a discussion of the problems with the prior processes).

It is this technical feature that defines the contribution which each of the Groups, taken as a whole, makes over the prior art.

In addition, it appears that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirements relating to the form and contents of the International application different from or additional to those which are provided for in the Patent Cooperation Treaty and the Regulations.

In addition, Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

Applicants submit that criteria (A) and (B)(1) are met by the compounds in the present claims and that they are of similar nature as that term is defined in Annex B above. For criteria (A), the common property or activity is that the compounds of formula (I) can be reacted with the compound of formula (II) in the presence of hydrogen and a homogenous catalyst system comprising RH, Ru, Ir, Pd, Pt, Co, and Ni with formula (IV) or (V) to prepare amines of formula (III). For criteria (B)(1), the common structural element is each of formulas (I), (II), (III), as well as the catalyst components, e.g., formulas (IV) or (V).

In view of the above, Applicants request that the Restriction Requirement be withdrawn.

Applicants also request that this application be passed to issuance.

Respectfully submitted,

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